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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/880,514 | 06/12/2001 | Pamela A. Kramer | ACS 54812 (23471) | 5333 |

24201 7590 08/06/2004

FULWIDER PATTON LEE & UTECHT, LLP
HOWARD HUGHES CENTER
6060 CENTER DRIVE
TENTH FLOOR
LOS ANGELES, CA 90045

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| EXAMINER |
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NOLAN, SANDRA M

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| ART UNIT | PAPER NUMBER |
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1772

DATE MAILED: 08/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/880,514

Applicant(s)

KRAMER, PAMELA A.

Examiner

Sandra M. Nolan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2004 and 24 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43 and 46-48 is/are allowed.
- 6) ☒ Claim(s) 25-42, 44, 45, 49, 51, 54 and 58-67 is/are rejected.
- 7) ☒ Claim(s) 50, 53, 56 and 57 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claims

1. Claims 25-67 are pending.

Allowable Subject Matter

2. Claims 43 and 46-48 are allowed.
3. Claims 50, 53, 56 and 57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
4. The prior art of record fails to teach or suggest processes having all of the features recited in claims 43, 44, 46-48, 50, 53, 56 or 57.

Rejections Withdrawn

5. All of the 35 USC 112 rejections set out in the 12 March 2004 office action (the last office action) have been withdrawn in view of applicant's arguments in the 24 May 2004 and 14 April 2004 responses (the last response).
6. All of the 35 USC 102 rejections stated in the last office action have been withdrawn in view of the arguments in the last response.
7. All of the 35 USC 103 rejections stated in the last office action have been withdrawn in view of the arguments the last response.

New Rejections

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claims 25-42 and 64-65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

What does "hvo" mean? The use of this abbreviation in the claims renders them unclear.

Please clarify.

10. Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 30, which depends on claim 25, calls for coating with composites.

However, the list of coating materials in claim 25 does not include composites.

Therefore, there is no antecedent basis for "a composite material" in claim 30.

Please clarify.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 25, 28, 29, 20, 31, 44, 49, 52, 54-55 and 58-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Seitz (US 6,431,464).

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Seitz teaches medical implants (col. 4, lines 38-39) that are coated via a thermal spraying processes (col. 1, lines 29-30) that includes the use of an arc (col. 3, lines 31-34) and coating with materials containing stainless steel (col. 3, lines 49-51), metal or cermets, (col. 1, lines 15-16), Ti and Ni (col. 4, lines 7-21). The coatings have cracks in them (col. 4, lines 43-45). Polymer coatings are applied (col. 4, lines 44-49).

The examiner interprets the cracks in the coatings to be porous.

The arc spraying of Seitz is deemed to be a cold process. Recall that applicant stated, at page 11, lines 6-7 of the specification, that arc spraying is a cold process.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. Claims 26 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seitz.

Seitz is discussed above.

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It fails to teach varied thickness, the growth of grains or the claimed post-coating processes.

The use of coatings of various thicknesses is a matter of design/engineering choice, depending upon the thicknesses desired.

The growth of grains during or after deposition of the coatings is to be expected, since the particles are molten when they are sprayed and molten particles will combine with others and "grow" during and after spraying.


The post-coating processes claimed are not deemed to render the processes claimed patentable since they relate to intended uses of the coated substrates.

Response to Arguments

16. Applicant's arguments with respect to claims 25-67 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication should be directed to Sandra M. Nolan, whose telephone number is 571/272-1495. She can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time. If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498. The fax number for patent application documents is 703/872-9306.



S. M. Nolan
Primary Examiner
Technology Center 1700

SMN/smn
09880514(20040803)